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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/865,371	05/25/2001	Earl Walter Emerick	ROC920010109US1	3728
7590	04/14/2006		EXAMINER	
Gero G. McClellan Thomason, Moser & Patterson, L.L.P. 3040 Post Oak Boulevard, Suite 1500 Houston, TX 77056-6582			LANEAU, RONALD	
			ART UNIT	PAPER NUMBER
			3627	

DATE MAILED: 04/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/865,371	EMERICK ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Ronald Laneau	3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 30 January 2006.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-46 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date. _____.   |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____.                                   |

***Response to Amendment***

1. The amendment filed on 1/30/06 has been entered. Claims 1-46 remain pending.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bhat (US 5,668,995) in view of Cline et al (US 2002/0087897 A1).

Bhat discloses a method of operating a computerized system to provide computer recommendation information for a plurality of computers, including the steps of generating an operation profile for a computer using machine information specific to the computer (see abs.), wherein the operation profile indicates at least a usage trend for the computer and generating a recommendation for at least one computer system solution which satisfies at least the projected requirements (see claim 19, paragraph d). Bhat further discloses the steps of generating the operation profile, receiving the machine information from the computer via a network connection (see figs. 2A, 2B; all information is received within the network). Bhat discloses a system that can collect the system's performance at intervals shorter than the first timed intervals as claimed (see fig. 1); a system wherein the plurality of system options are provided by a plurality of third party solution providers (col. 5, lines 60-65), further include the steps of configuring the at least one computer system solution to indicate system specifications and a

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price (col. 6, lines 32-38). Jon does not disclose a computer system solution based on the usage trend as claimed but Cline discloses determining projected requirements for at least one computer system solution based on the usage trend for the computer (page 3, [0038] – [0039]); further discloses future possible configurations for a computer system wherein a user of the system is allowed to make modifications to the configuration whether it's the specifications or price (page 3, [0034]).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the system solution based on the usage trend as taught by Cline into the system of Bhat because it would provide such comprehensive control over operational states of a computer system.

As per claims 3-4, 6-7, 13, 19, 28-29 and 33, the system as taught by Bath is well capable of allowing a user to modify the recommendation base on the usage patterns of the network and also generating recommendation comprising processing system requirements specifications reflecting a desire d future use of the computer (see fig. 1).

As per claims 9, 11-12, 14, 20-22, 33, 35-36, 40, 42, 44 and 45, Bhat discloses configuring the at least one computer solution to indicate specifications and price; receiving a purchase order for configured system; receiving a configuration selection from the user to modify the starting configuration; determining whether the configuration selection is valid; and if so, producing a configured system viewable by the user (col. 1 lines 52 to col. 2, line 10).

***Response to Arguments***

4. Applicant's arguments with respect to claims 1-46 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's arguments are moot in view of the newly added reference in Bhat (US 5,668,995). Applicant argues that the Examiner has cited an alleged benefit taught by Cline namely "selecting an operational state of a computer system" as a motivation to combine aspects of Cline with the other reference. In response to Applicant's arguments, this is a proper way to combine references because the advantages or benefits found in the teachings of Cline would be one of the reasons for combining the references. Applicant further argues that the examiner fails to make a *prima facie* case of obviousness since there is no suggestion or motivation to modify the references or combine reference teachings so as to arrive at the claimed invention. In response to applicant's arguments, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this particular case, the motivation was found in the reference itself. Furthermore, Applicant argues that the references fail to disclose "generating a recommendation" are moot in view of the newly added reference which discloses such features. Claims 1-46 remain rejected.

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***Conclusion***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ronald Laneau whose telephone number is (571) 272-6784. The examiner can normally be reached on Mon-Fri from 8:30am - 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Ronald Laneau*

Ronald Laneau  
Examiner  
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